

PATENT

App. Ser. No.: 09/837,389
Atty. Dkt. No. ROC920000331US1
PS Ref. No.: IBM2K0331

REMARKS

This is intended as a full and complete response to the Final Office Action dated December 16, 2005, having a shortened statutory period for response set to expire on March 16, 2006. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-8 and 10-16 are pending in the application. Claims 1-8 and 10-16 remain pending following entry of this response.

Claim Rejections - 35 U.S.C. § 102

Claims 1-8 and 10-16 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Blumenau et al.* (US Pat. No. 6,665,714 B1, hereinafter "*Blumenau*"). Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Blumenau* does not disclose "each and every element as set forth in the claim". As discussed previously, *Blumenau* generally discloses a method and apparatus for managing the availability and assignment of data in a storage system that is coupled to a network. However, *Blumenau* does not teach, show or suggest the steps performed by the host server operating system and by the network server operating system, respectively, in response to requests sent to each other as claimed.

For example, *Blumenau* does not disclose adding a new disk drive image to a network server description for the network server through a host server operating system. The Examiner argues that *Blumenau* discloses such features at col. 31, line 15 to col. 32, line 11. However, the cited passage is in fact directed to a GUI which has

Page 6

436398_1

PATENT

App. Ser. No.: 09/837,389

Atty. Dkt. No. ROC920000331US1

PS Ref. No.: IBM2K0331

expandable icons that may display existing storage volumes of a storage system. No "new disk drive image" is added, and only existing storage volume icons are displayed by clicking on a storage system icon.

As another example, *Blumenau* does not disclose sending a device scanning request from the network server operating system to the host server operating system in response to a dynamic linking request. In this regard, the Examiner argues that *Blumenau* discloses showing the available devices. However, such available devices are merely icon displays of storage systems and associated storage volumes. No device scanning request is sent. Applicants submit that clicking on an icon to expand the icon is not equivalent to a device scanning request.

As another example, *Blumenau* does not disclose requesting a response from each device connected to each SCSI port of a host server in response to the device scanning request. The Examiner argues that *Blumenau* discloses identifying the storage devices connected to a server. However, the passages and figures cited by the Examiner are merely directed to a GUI showing the user selected components that are connected. *Blumenau* simply does not teach show or suggest requesting response from each connected device, particularly, in response to a device scanning request.

In response to Applicants' arguments, the Examiner states that the Applicants' arguments "in substance" are as follows.

"A) Blumenau does not disclose steps performed by a host server and by network server in response to a request.

B) Blumenau does not disclose scanning request from the network server operating system to the host server operating system in response to a request."

In response to A), the Examiner states that "Blumenau discloses the host communicates with the disk drives in response to the user request (see col. 19 lines 10 - 30)." Applicant submits that the cited portions of the reference generally disclose a topology of a networked storage system and do not disclose the requests sent by and responses performed by the host server operating system and the network server operating system, respectively. The general communication in a networked environment as disclosed in *Blumenau* do not teach, show or suggest the requests sent

Page 7

438398_1

PATENT

App. Ser. No.: 09/837,389
Atty. Dkt. No. ROC920000331US1
PS Ref. No.: IBM2K0331

and responses performed by the respective systems as claimed. More particularly, *Blumenau* do not teach, show or suggest:

"sending a dynamic linking request from the host server operating system to a network server operating system;

in response to the dynamic linking request, sending a device scanning request from the network server operating system to the host server operating system;

in response to the device scanning request, requesting a response from each device connected to each SCSI port of a host server and reporting the new disk drive image to the network server operating system."

In response to B), the Examiner states that "Blumenau discloses a user graphically connects a server to a host, in response to the connection request the host identifies all the disk devices connected to the host and the disks that the user has access to and presented to the user as shown in fig. 14 (see col. 21 line 60 - col. 22 line 28). The Examiner interprets the identifying of the disks drives status and access privileges as 'response from connected devices in response to device scanning request.'" Applicants respectfully submit that the Examiner has improperly interpreted the cited portions of the reference. The cited passages disclose a utility for "providing additional identification information pertaining to hosts and host/HBA pairs that are logged into a storage system." The cited passages do not disclose "sending a device scanning request from the network server operating system to the host server operating system;" and "in response to the device scanning request, requesting a response from each device connected to each SCSI port of a host server."

Applicants respectfully submit that the Examiner has not given due consideration to the relationships between the requests sent and the respective responses performed by the respective components. The claims are believed to be allowable, and allowance of the claims is respectfully requested.

Claim Rejections - 35 U.S.C. § 103

Claims 1-8 and 10-16 are rejected under 35 U.S.C. § 103(a) as being anticipated by *Blumenau*. Applicants respectfully traverse this rejection.

Page 8

436398_1

PATENT

App. Ser. No.: 09/837,389
 Atty. Dkt. No. ROC920000331US1
 PS Ref. No.: IBM2K0331

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish these criteria.

Firstly, the Examiner has not provided any analysis with respect to these obviousness rejections. Secondly, in view of Applicants' arguments above, *Blumenau* does not teach, show or suggest all of the claim limitations as claimed.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

PATENT

App. Ser. No.: 09/837,389
Atty. Dkt. No. ROC92000331US1
PS Ref. No.: IBM2K0331

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

If the Examiner believes any issues remain that prevent this application from going to issue, the Examiner is strongly encouraged to contact Gero McClellan, attorney of record, at (336) 643-3065, to discuss strategies for moving prosecution forward toward allowance.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

/Gero G. McClellan, Reg. No. 44,227/

Gero G. McClellan
Registration No. 44,227
PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicants